

Remarks

I. Status of Claims

Claims 1 and 11-14 are pending. Claim 1 is the only independent claim. Without waiving any argument, and to advance prosecution, claims 2-10 and 16-19 are canceled without prejudice to and/or disclaimer of the subject matter therein. Claim 1 is amended to include subject matter generally tracking canceled claims 2 and 7, thus, no new matter is added.

The Office Action objects to claim 19 for a minor informality.

Claims 1, 2, 8, 9, 13, 14, and 18 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Braun (USPGPUB 2004/0144367) (“Braun”) in view of Goplen (USP 4,872,528) (“Goplen”).

Claims 7, 10-12, and 19 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Braun in view of Goplen, as applied above, and further in view of Langer (USP 5,452,577) (“Langer”).

The Applicants respectfully request reconsideration of these rejections in view of the foregoing amendments and the following remarks.

II. Claim Objection

The Applicant respectfully submits that the cancellation of claim 19 obviates this objection.

III. Remarks Regarding Rejections

a. Certain embodiments of the present invention

Certain embodiments of the present invention, such as, for example, FIGS. 1-2¹ reproduced herein below, include an inner pipe 30. The inner pipe includes an open end 31 through which an interior of the inner pipe communicates with atmosphere, and a noise emission decreasing device 40 for decreasing a noise emitted from the open end 31 of the inner pipe 30. Also, the noise decreasing device of certain embodiments of the present invention is made separately from the inner pipe and fixed to the ends of the inner pipe so as to decrease the vibration energy (noise) emitted from the inner pipe.

¹ FIGS. 1-2 were the only FIGs elected in a previous response to an election of species requirement.

FIG. 1

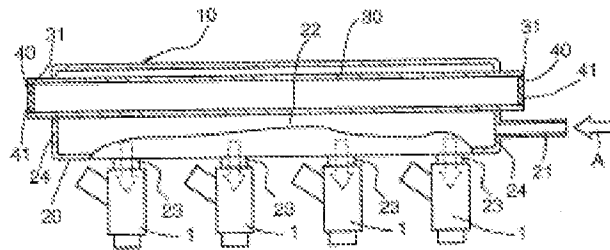
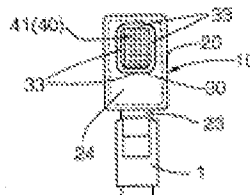


FIG. 2



In this example, the noise emission decreasing device 40 includes a mesh 41 which, when the air vibration generated inside the inner pipe 30 passes through the mesh 41, an energy of the vibration is absorbed and dispersed by the mesh 41. Accordingly, the noise emitted from the delivery pipe 10 is effectively decreased. As can be seen in FIG. 2, the noise emission decreasing device is provided at all portions of a cross section of an interior of the inner pipe. *See also* paragraph [0065] of the application as published.

b. Independent Claim 1 of Proposed Revised Claim Set

Independent claim 1 has been amended to include subject matter generally tracking claims 2 and 7 (now canceled), thus, it would appear that this claim would stand rejected under 35 USC 103(a) as allegedly being unpatentable over Braun in view of Goplen, and further in view of Langer.

It is respectfully submitted that claim 1 is patentable over the cited references at least because it recites, *inter alia*, "...a noise emission decreasing device **including a mesh** and located within the inner pipe..." and "...wherein the noise emission decreasing device is provided **at all portions of a cross section of an interior of the inner pipe**...." (emphasis added)

With respect to Braun, FIG. 5 of which is reproduced herein below, this reference does not describe a mesh as a noise emission decreasing device.

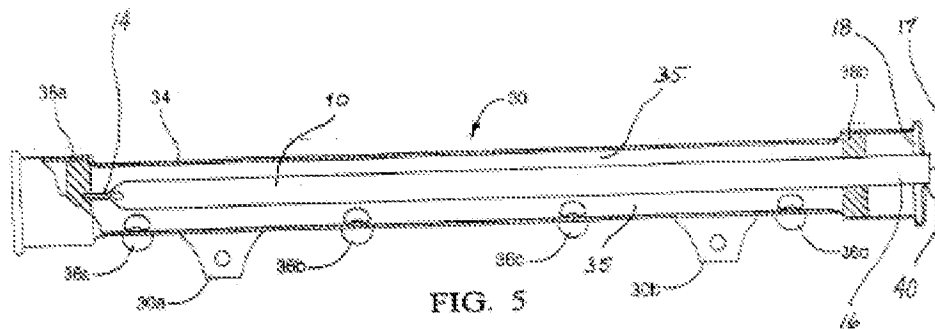


FIG. 5 of Braun

Accordingly, the Office Action cites Goplen to address this deficiency. In FIG. 2 of Goplen, reproduced herein below, it can be seen that Goplen does not describe a mesh that is provided at all portions of a cross-section of an interior of the inner pipe. Instead, the alleged mesh has a tapered cross-section.

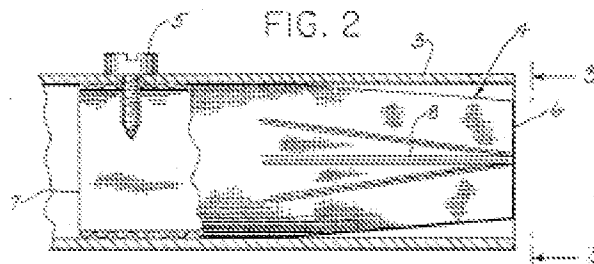


FIG. 2 of Goplen

Therefore, the Office Action cites Langer. More specifically, the Office Action (on pages 6-7) alleges that as follows:

Braun and Goplen fail to explicitly teach wherein the noise emission decreasing device is provided at all portions of a cross section of an interior of the inner pipe; wherein the noise emission decreasing device is disposed at only a portion of a circumference of an inside surface of the inner pipe...Langer teaches wherein it is known to provide sound absorbing material at either all or only portions of an inner piper (Col 1, Lines 44-64) to achieve a desired reduction of noise in a conduit...It would have been obvious to one of ordinary skill in the art at the time the invention to combine the apparatus of Braun *as modified*, with the apparatus of

Langer to apply the silencing layer to locations which are particularly critical with respect to vibration so that an optimum system can be achieved with respect to noise emission.

In other words, the Office Action is proposing to modify Braun with Goplen, and Goplen with Langer to arrive at the invention of claim 1. It is respectfully submitted that at least the modification of Goplen with Langer is improper.

More specifically, as discussed in MPEP § 2143, if the proposed modification or combination of the prior art (i.e., Goplen) would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143 quoting *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)². In the instant case, an express object of Goplen is to provide a tapered screen to “increase surface area and minimize restriction to flow.” See column 1, line 40, of Goplen. As described in col. 2, lines 30-35 of Goplen:

The tapered condition of screen 4 provides increased surface area and minimizes the restriction to flow. It is believed that the screen changes the flow pattern near the end of the outlet conduit 3 and prevents eddys from spilling out from the end of conduit 3, thereby reducing the sound level.

Thus, if Goplen were modified as proposed, an express object for which it was designed to operate could not be achieve. Accordingly, it is respectfully submitted that proposed combination of Braun, Goplen, and Langer is improper and should be withdrawn because it changes the basic principle under which Goplen was designed to operate.

Also, it is respectfully submitted that none of the other cited references identify a reason why one having ordinary skill in the art would modify Braun and/or Goplen in the manner as

² (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] **as well as a change in the basic principle under which the [primary reference] construction was designed to operate.**” 270 F.2d at 813, 123 USPQ at 352.). See MPEP § 2143. (emphasis added)

claimed by the Applicant. As discussed in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it is necessary to identify the reason why a person of ordinary skill in the art would have been prompted to modify the cited references in the manner as recited in the invention of claim

1. Obviousness cannot be sustained by mere conclusory statements.

Therefore, for at least these reasons, it is respectfully submitted that claim 1 and its dependent claims are patentable over the cited references.

IV. Conclusion

In view of the foregoing discussion, the Applicants respectfully submits that the present application is in all aspects in allowable condition. Favorable reconsideration and early issuance of a Notice of Allowance are therefore respectfully requested.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: March 3, 2010

By: /Daniel G. Shanley/
Daniel G. Shanley
Reg. No. 54,863

KENYON & KENYON LLP
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201